does not explicitly require its affinity values to be obtained based on content alone (although they are) in contrast to the express limitation of Claim 13.

The above summary of the rejections reveals their legal incorrectness. Turning first to the rejections of Claims 12 and 13, Applicants note that the burden is on the examiner to show where each and every limitation is taught or suggested in the prior art. The present rejection, however, does not attempt to rebut Applicants' assertion that Deerwester is, in fact, limited to affinity values that are symmetric and thus does not teach affinity values that are not constrained to be symmetric, in contrast to Claim 12. That is because Deerwester indeed appears to be so limited, as advanced by Applicants. Nor does the Office Action attempt to rebut Applicants' assertion that Deerwester, in fact, produces affinity values that are based on content alone, in contrast to Claim 13. Again, that is because Deerwester indeed appears to be so limited. Instead, Claims 12 and 13 have been rejected solely because no express statement by Deerwester such as "my invention is limited to symmetric, content-based affinity values" appears in the Deerwester patent, even though the Deerwester invention appears to inherently require it. Consequently, the present rejection would appear to fail to comply with the Manual of Patent Examining Procedure (MPEP) §2142 et seq. in that each and every element of Claims 12 and 13 have not been identified in the prior art. Accordingly, the rationale for the rejections of Claims 12 and 13 advanced in the Office Action are reversible error.

Now considering the rejection of Claim 1, it is axiomatic that simply because a reference can be modified (and it is not clear how Deerwester could in fact be modified to use hyperlinks), it is insufficient to establish a prima facie case of obviousness unless the prior art motivates the modification, MPEP §2143.01 (citing In re Mills). No prior art suggestion to combine Deerwester with Barrett et al. has been identified. Rather, the Office Action simply states that Barrett et al. shows "that related entities are linked by hyperlinks.

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Clearly, at least one affinity value depends on at least in part on at least one hyperlink since hyperlinks are linking related entities retrieved by a search engine."

As best understood, what the Office Action is saying is that once Deerwester is modified to use the hyperlinks of Barrett et al., then the affinity values would depend on hyperlinks. This jumps over the critical step of making a prima facie case of obviousness, however, in that no prior art motivation to modify Deerwester to use Barrett et al.'s hyperlinks is identified in the first place. Thus, the present rejection fails to establish a prima facie of obviousness in accordance with the MPEP and should be withdrawn.
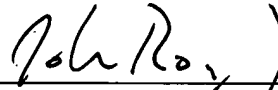
Furthermore, Applicants can discern no prior art reason to modify Deerwester to use hyperlinks. Deerwester is directed to database mining by identifying associations between terms of documents, as set forth in the background of Deerwester. Hyperlinks, in contrast and as correctly noted by the Examiner, are references from one document to another that are independent of terms in the documents. Nothing in Deerwester appears to motivate relating documents by anything other than common terms; consequently, nothing in Deerwester appears to provide the impetus to relate documents by references to each other.

Applicants' position is bolstered by Deerwester itself. Specifically, col. 8, line 65 to col. 9, line 5 of Deerwester appears to be the only place in Deerwester that mentions the Internet, yet nothing in this short paragraph refers to "hyperlinks". It accordingly would seem most difficult to find a suggestion in Deerwester to gut its algorithm of its central theme - term affinity - and replace it with another protocol, namely, affinity as evidenced by references, not terms, when Deerwester itself does not mention "hyperlinks" when it addresses Internet data mining using term affinity.

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The lack of suggestion in Deerwester to use hyperlinks in a document-relating context does not appear to be cured by the secondary reference, in that the secondary reference is directed to a completely different problem than relating documents, namely, keeping track of Web site access statistics.

Applicants respectfully assert that the presently claimed invention is patentably distinct from the cited references, and Applicants therefore request that the present rejections be withdrawn and the instant application passed to allowance. The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

Respectfully submitted,

John L. Rogitz
Registration No. 33,549
Attorney of Record
750 B Street, Suite 3120
San Diego, CA 92101
Telephone: (619) 338-8075

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